

RECEIVED
CENTRAL FAX CENTER

OCT 15 2008

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant(s): Lane W. Lee; Timothy R. Feldman; Douglas M. Rayburn;
Gary G. Kiwimagi
Assignee: DPHI Acquisitions. Inc.
Title: Revocation Method and Apparatus For Secure Content
Application No.: 09/939,896 Filing Date: August 27, 2001
Examiner: Chrystina Zelaskiewicz Group Art Unit: 3621
Docket No.: M-12042 US Confirmation No.: 4074

Irvine, California
October 14, 2008

Via Facsimile to (571) 273-8300

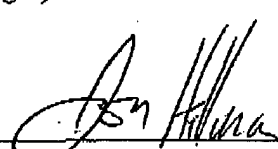
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

CERTIFICATION OF FACSIMILE TRANSMISSION

I hereby certify that the following documents are being facsimile transmitted to the U.S. Patent and Trademark Office on the date shown below;

1) Appellant's Reply Brief (8 pages)

Dated: October 14, 2008


Jonathan W. Hallman
Registration No. 42,622

Number of pages (including this sheet): 9

MacPherson Kwok Chen & Heid LLP
2033 Gateway Place, Ste. 400
San Jose, CA 95110

Telephone: (949) 752-7040
Fax: (949) 752-7049

Fax to USPTO

**RECEIVED
CENTRAL FAX CENTER**

OCT 15 2008

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Inventor: Lane Lee, et al.

Application No. 09/939,896

Filing Date: 08/27/2001

For: Revocation Method and Apparatus for
Secure Content

Examiner: Chrystina Zelaskiewicz

Art Unit: 3621

Confirmation No. 4074

Attorney Docket No.: M-12042 US

APPELLANTS' REPLY BRIEF

RECEIVED
CENTRAL FAX CENTER

OCT 15 2008

Status of Claims

Claims 1 – 35, and 41 – 43 are cancelled.

Claims 36 – 40 are pending and are finally rejected by the Office Action dated February 23, 2007.

The rejection of claims 36 – 40 is appealed.

Grounds of Rejection to Be Reviewed on Appeal

- 1) Whether, under 35 U.S.C. § 102(e), claims 36 – 40 are anticipated by U.S. Publication No. 2003/0046238 to Nonaka.

Argument.

1) Rejection under 35 U.S.C. 102(e) over U.S. Publication 2003/0046238 to Nonaka

Claims 36-40:

As an initial matter, the Applicants gratefully acknowledge the Examiner's indication that the rejection for lack of antecedent basis has been overcome in conjunction with the filing of the Rule 41.33 amendment. However, Applicants note that the Examiner's Answer raises the following issue (for the first time): that the Applicants file-by-file revocation scheme is merely a recitation in the preamble of claim 36 as opposed to being actively claimed (see the Examiner's Answer's, page 9, last paragraph). Applicants respectfully note that such an assertion is analogous to the Examiner's position taken with regard to the Applicants' summary section in their opening brief: that the summary section did not include a "concise explanation of the subject matter" without any argument given to support such an assertion. Claim 36 plainly does have a file-by-file limitation in its body: specifically, claim 36 recites a first act of "receiving at the storage engine a file request from the host device, the file request being directed to a file stored on a storage medium accessible to the storage engine." Claim 36

then recites a subsequent act of "reading a revocation list associated with the file from the storage medium, the revocation list containing at least one rule, the at least one rule associating data in the revocation list with data in the certificate" (emphasis added). Applicants have underlined the limitation "the file" because such a definite article usage with regard to "file" requires that the reading act follow the file request act. In other words, reading the revocation list follows the file request because of the file-by-file nature of the revocation.

As discussed in their (proper and compliant) summary section in their opening brief, prior art revocation schemes are not associated with files but instead with devices (and thus ultimately with the user of that device): a content provider decides a device is rogue and thus revokes that device. That revocation is not associated with a file but instead with the device (or user associated with the device). It is "all or nothing" because once a device is revoked, that is it – there is no further content access.

Nonaka has such a conventional revoke-the-device revocation scheme. Specifically, consider the networked audio-visual devices (which may also be denoted as media players) 106 in Nonaka's Figure 1: each such device has an associated "secure application module" (SAM) 105. As described in ¶336, each audio-visual device includes a built-in SAM. It is this SAM that is revoked as discussed in ¶671: and note that this paragraph makes it explicit that the checking of the revocation list by the electronic music distribution (EMD) service center 102 (of Figure 1) occurs during registration of the SAM, not responsive to a file request by a host device.

The second point (the first point being the incorrect assertion that Applicants' claimed file-by-file revocation scheme was merely a recitation in the preamble) on page 10 of the Examiner's Answer is that under a broadest reasonable interpretation of the claims, a rejection of the SAM is a file-by-file rejection. Applicants note the Examiner's Answer is fuzzy on exactly how the device-based SAM revocation is a file-by-file revocation: evidently, the Examiner's Answer is proposing that by rejecting the device including the SAM, you reject all files within the device and thus that is somehow a file-by-file

rejection. But such a flawed reasoning does not account for the required limitation that the revocation be responsive to a particular file request: instead, the Nonaka SAM revocation is with regard to a registration request of the device (each device having a unique SAM). So there can be no file-by-file revocation with regard to a Nonaka "audio-visual display" device: either the device (and all associated files) is revoked upon registration or the device is registered and not revoked.

The Examiner's answer's third point (on page 10) is that a Nonaka device (which has an associated SAM) could have access to just one file and as such would be a file-based revocation. But note the flaw in such reasoning: all conventional devices that are revoked on a device basis (as is Nonaka) could conceivably have just one file. But a revocation of such devices is not responsive to a file request as required by claim 36: it is instead with regard to an initial registration/authentication of the device.

Applicants note that the Examiner's Answer has also muddled the required limitation of "host device." A host device is a well-known term in the digital rights management arts: in one embodiment, it is a host PC that reads content through a storage engine such as a hard disc drive. The storage engine reads/writes content from an associated storage medium (in the case of a hard disc drive, the storage medium is the magnetic hard disc). The revocation scheme of claim 36 is carried out between the host device and the storage engine. The first element of claim 36 is the act of "receiving at a storage engine a certificate from the host device, the certificate containing a digital signature." The Examiner's Answer contains a table on pages 6-7 that addresses the claim limitations in claim 36. To satisfy this first element of claim 36, the Examiner's Answer points to ¶¶ 435, 462-494 of Nonaka. Nonaka's ¶435 is describing the contents of a storage unit 192 within an audiovisual device's SAM 105 as shown in Figure 30. Similarly, ¶¶462-494 of Nonaka describes various authentications of the "secure container" being downloaded to the audiovisual device. Thus, it is entirely unclear what the Examiner's Answer intends to use to satisfy the "host device" element: if the Examiner is pointing to the EMD service center as the

host device, then the revocation is "wrong way directed" because it is the audiovisual device's SAM that is being examined for revocation, not the EMD service center (claim 36 is directed to a revocation of a file request from a host device). If the Examiner's Answer is pointing to the host CPU 810 within the home network containing the audiovisual device (Figure 22), that host is never revoked either. Instead, it is the audiovisual device's SAM that is revoked.

The Examiner's Answer devolves further with regard to the second element of claim 36 of "authenticating the digital signature." The entry in the table on page 6 of the Examiner's Answer points to ¶¶22-28, 56-66 and Figures 60 and 61 of Nonaka to satisfy this element. But Nonaka's ¶¶22-28 are merely describing features of a "data processing apparatus" that Nonaka indicates corresponds to the SAM (see ¶179). There is no discussion in ¶¶22-28 of how the SAM is receiving a certificate from a host device, let alone whether the SAM then authenticates a digital signature of the host device. Nonaka's Figures 60 and 61 are merely directed to revocation lists created by the EMD service center: as discussed above, if the Examiner's Answer depends upon the EMD service center satisfying the recited "host device" limitation, the entire analysis is flawed because the EMD service center is never revoked. Instead, it is the SAM that is revoked.

The Examiner's Answer devolves yet further with regard to the third element of claim 36 of "establishing a secure session by transmitting a session key to the host device." Here, the table on page 6 of the Examiner's Answer points to encryption/decryption unit 171 of the SAM (see Figure 30) to satisfy this element. But this unit is plainly decrypting the data received from the content provider and the EMD service center: again the Examiner's Answer has muddled the concept of "host device" with remote devices that are never revoked: it is the content provider and the EMD service center that do the revoking of the SAM, yet the Examiner's Answer says that Nonaka's revocation of the SAM somehow anticipates a revocation scheme wherein a storage engine revokes a file request from a host device: in other words, the Examiner's Answer's claim 36 interpretation requires the SAM to revoke the EMD service

center, which is plainly wrong.

The Examiner's Answer again misses the mark with the fourth element of claim 36 of "receiving at the storage engine a file request from the host device, the file request being directed to a file stored on a storage medium accessible to the storage engine." The table on page 6 of the Examiner's Answer points to ¶¶ 435, 671-675 of Nonaka. But as discussed above, Nonaka's ¶ 435 is merely discussing the contents of a storage unit within the SAM. There is not a shred of a suggestion in Nonaka's ¶ 435 with regard to a file request from a host device, let alone an anticipation of such an act. Similarly, Nonaka's ¶¶ 671-675 are describing how the EMD service center may revoke a SAM upon registration. Applicants are at a loss to fathom how such a disclosure possibly anticipates the fourth element of claim 36.

Similarly, the Examiner's Answer does not establish a disclosure of the fifth element of claim 36 of "reading a revocation list associated with the file from the storage medium, the revocation list containing at least one rule, the at least one rule associating data in the revocation list with data in the certificate." The table on page 7 points to ¶¶ 435, 671-675 of Nonaka to satisfy this claim element. But such a reading of Nonaka is fatally flawed because ¶ 435 of Nonaka is just describing the contents of the storage unit within the SAM whereas ¶¶ 671-675 of Nonaka are directed to the evaluation for revocation by the EMD service center of the SAM. As discussed above, the EMD service center can never serve as the recited "host device" in claim 36 because the EMD service center is never revoked, let alone revoked with regard to a (entirely missing and undisclosed) file request by the EMD service center.

Similarly, the Examiner's Answer fails to establish a disclosure of the sixth and seventh elements of claim 36, namely that of "applying the at least one rule on the data in the revocation list and the associated data in the certificate; and if the application of the at least one rule provides a failing result, denying the file request." To satisfy these limitations, the table on page 7 of the Examiner's Answer points to Nonaka's ¶¶ 247, 671-675 as well as to Figures 60-61. But ¶ 247 of Nonaka has nothing to do with revocation list rules but instead is directed

to rules for suggested retail price and copying privileges. Such rules may be interesting but have nothing to do with a revocation of the SAM. Nonaka's ¶¶ 671-675 are directed to the EMD service center checking for revocation of the SAM and again have nothing to do with regard to any rules within the revocation list.

It may thus be seen that there is not a shred of a suggestion in Nonaka of the recited "file request" by a host device in claim 36, let alone the examination of such a request by a storage engine with regard to whether the host device should be revoked with regard to this file request. Applicants admire the zeal that has been demonstrated by the Examiner's Answer with regard to arguing that Nonaka anticipates claim 36: in that regard, it may be supposed that an examination of such a large and lengthy reference such as Nonaka may lead one to believe that surely such a reference must disclose many things: indeed, Applicants agree that there must be many features within the 100 plus pages of Nonaka – but the law requires the examiner to show that claim 36 "is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference (MPEP §2131). As discussed above, the Examiner has failed with regard to each element of claim 36: in other words, not a single limitation of claim 36 is disclosed by Nonaka yet this reference has been repeatedly cited over and over as anticipating Applicants' claims.

Applicants observe that the Examiner's Answer contained an "Examiner's Note" section on pages 10-11 wherein it was stressed that "Applicant is presumed to have actual knowledge of statutes, rules, and applicable caselaw." Applicants respond that they are under no duty whatsoever of having any such knowledge: it is instead the burden of the Examiner to understand and apply applicable statutes, rules, and caselaw to formulate a proper rejection, a burden that has never been met despite seven years (!) of protracted examination.

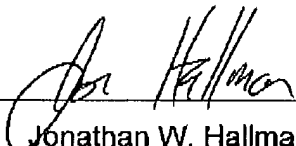
RECEIVED
CENTRAL FAX CENTER
OCT 15 2008

Conclusion

Therefore, in light of the foregoing arguments, Applicants respectfully request the Honorable Board of Appeals to reverse the decision of the Examiner with respect to claims 36 – 40.

Respectfully submitted,

Date: Oct. 14, 2008

By: 
Jonathan W. Hallman
Reg. No. 42,622